



May 20, 2021

VIA EMAIL

Thomas Tansy
Chairman
SunSpec Alliance
4040 Moorpark Avenue, Suite 110
San Jose, CA 95117
tom@sunspec.org

Re: Infringement of Tigo Energy's Patents

Dear Mr. Tansy:

Tigo has been a technology leader in photovoltaic safety for many years. Tigo has been awarded many patents related to technology solutions for the module-level rapid shut-down requirements imposed by NEC 2017, including U.S. Patent Nos. 7,884,278; 8,271,599; 9,124,139; 8,854,193; 9,377,765; 8,933,321; 8,823,218; 9,397,612; 8,653,689; 8,325,059; 9,143,036; 8,274,172; 9,007,210; 9,966,848; 9,813,021; 10,063,056; 10,256,770; 10,312,857; and 10,333,405, as well as additional U.S. patents and patent applications that claim priority from those patents (the “Tigo Rapid Shutdown Patents”).

Tigo's work in this area predates SunSpec. Many Tigo patents were published before SunSpec started working on the Communication Signal for Rapid Shutdown SunSpec Interoperability Specification (the “SunSpec RSD Specification”). On October 30, 2017, Tigo provided SunSpec with formal notice that it owned U.S. patents with claims that were necessary to practice the SunSpec RSD Specification. Specifically, in 2017 Tigo notified SunSpec that the following U.S. Patents contain necessary claims: 7,884,278; 8,271,599; 9,124,139; 8,854,193; 9,377,765; 8,933,321; 8,823,218; 9,397,612; 8,653,689; 8,325,059; 9,143,036; 8,274,172; and 9,007,210.¹ SunSpec publicly acknowledged Tigo's claims in a “Member's Briefing” on November 1, 2017. SunSpec also public repeated that acknowledgement by posting the slides from that meeting on its website.²

In January 2020, SunSpec asked Tigo to agree to negotiate with its member companies and agree to license its intellectual property related to rapid shutdown to these companies on reasonable and nondiscriminatory terms. SunSpec offered to facilitate initial licensing negotiations between

¹ Tigo is now notifying you that since 2017, additional U.S. Patents have been issued to Tigo which claim priority to the patents identified to you in 2017, and that those additional patents also contain claims that are necessary for the “RSD Specification.”

² <http://sunspec.org/wp-content/uploads/2019/08/RapidShutdownIPbriefing20171101.pdf>



Tigo and its members. Tigo responded promptly, telling SunSpec that it was willing to license its patents on reasonable and nondiscriminatory terms.

Yet since then—despite knowing that Tigo owns patent rights that are required to use the SunSpec RSD Specification, and despite having offered to facilitate licensing negotiations with its members—SunSpec has been actively inducing its members to practice the SunSpec RSD Specification without obtaining a license to Tigo’s patents. In so doing, SunSpec is violating Tigo’s patent rights under U.S. patent law, specifically 35 U.S.C. § 271(b), which states that “Whoever actively induces infringement of a patent shall be liable as an infringer.” By actively encouraging its members to practice the SunSpec RSD Specification without a license to Tigo’s patents, SunSpec is actively inducing infringement of those patents.

One of the SunSpec members—APsystems—recently signed a license agreement with Tigo, and is now licensed under the Tigo Rapid Shutdown Patents. While Tigo is willing to license all other SunSpec members on substantially similar terms, to date no other SunSpec member has been licensed under any of the Tigo Rapid Shutdown Patents. Any continued unlicensed use by any SunSpec member of the SunSpec RSD Specification violates Tigo’s patent rights. Unlicensed use that SunSpec has been actively encouraging in the United States in violation of Tigo’s rights includes, for example, use by SunSpec members JMthy, Z-Run, and Fronius.

Tigo would like to resolve this matter amicably. SunSpec must stop inducing its members to infringe the Tigo Rapid Shutdown Patents by practicing the SunSpec RSD Specification without a license to those patents. Thus, SunSpec must notify its members that they need a license from Tigo to manufacture, use, import, sell, or offer to sell rapid shutdown devices that practice the RSD Specification. As I noted above, Tigo is willing to license all other SunSpec members on terms substantially similar to those agreed to by APsystems.

If SunSpec continues to violate Tigo’s patent rights by inducing its members to practice the RSD Specification without a license, then Tigo will take legal action to protect its rights, as it has done in the past.

Sincerely,

A handwritten signature in black ink, appearing to read "Zvi Alon".

Zvi Alon, CEO